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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,108	12/12/2003	Tomohiro Matsuda	CFA00023US	1918

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CANON U.S.A. INC. INTELLECTUAL PROPERTY DIVISION
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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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4172

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/735,108	Applicant(s) MATSUDA ET AL.	
	Examiner Christopher C. Johns	Art Unit 4172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/15/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

Claims 3, 14, and 19 objected to because of the following informalities: all of the claims make reference to "an intellectual property right held by a **manufacture** of the genuine product". The claims, as written, make more sense were the "manufacturer" to hold an intellectual property right. It is assumed that the applicant intended to put "manufacturer". Nevertheless, appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-21 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A "program product" is not included in the statutory fields of subject matter. See MPEP 2106.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-9, and 11-21 rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,974,150 (hereafter referred to as Kaish).

As per claims 1, 11, 12, and 17, Kaish discloses:

- inputting means for inputting product data (see Figures 2, 3; column 25, line 50—column 26, line 14);
- first determining means for determining whether or not the product data input by the inputting means includes first information that is attached to a genuine product and that is not attached to a third party product (see Figures 1, 2; column 9, lines 12-22, column 10, line 57 - column 11, line 2);
- second determining means for determining whether or not the product data input by the inputting means includes second information that is attached to only the genuine product (see Abstract; column 1, lines 22-25, column 9, lines 3-10);
- third determining means for determining that a product is a counterfeit product when the product data input by the inputting means includes the first information and does not include the second information (see Abstract; Figures 4a, 4b; column 11, lines 3-17, column 25, line 50 – column 26, line 14).

Claims 11, 12, and 17 are materially identical to claim 1, and are similarly rejected.

As per claims 2, 13, and 18, Kaish discloses:

- the product data includes image data (see Figure 1, reference numbers 3, 8, 9, 10).

Claims 2, 13, and 18 are materially identical to claim 1, and are similarly rejected.

As per claims 3, 14, and 19, Kaish discloses:

- the product data includes image data and the first determining means determines whether or not the image data includes, as the first information, an image that is protected by an intellectual property right held by a manufacture of the genuine product (see Figure 1, reference number 5).

Claims 3, 14, and 19 are materially identical to claim 1, and are similarly rejected.

As per claims 4, 15, and 20, Kaish discloses:

- the image comprises a registered trademark (see Figure 1, reference number 5).

Claims 4, 15, and 20 are materially identical to claim 1, and are similarly rejected.

As per claims 5, 16, and 21, Kaish discloses:

- the product data includes image data and the second determining means determines whether or not the image data includes, as the second information, an image that does not exist in a counterfeit product (see Figure 1, reference numbers 3, 8, 9, 10, Figures 4a, 4b; column 26, lines 28-48).

Claims 5, 16, and 21 are materially identical to claim 1, and are similarly rejected.

As per claim 7, Kaish discloses:

- the inputting means is means for inputting a determination request and the product data from another terminal (see column 26, lines 28-47);

- and the information processing apparatus further comprises transmitting means for transmitting a determination result obtained by the third determining means to the another terminal (see column 25, lines 42-49).

As per claim 8, Kaish discloses:

- the product data includes item data that indicates a type of product (see Figure 1);
- the information processing apparatus further includes a first database in which the first information is stored for each type of product and a second database in which the second information is stored for each type of product, and wherein the first determining means searches the first database in accordance with the item data to retrieve the first information and determines whether or not the input product data includes the retrieved first information, and the second determining means searches the second database in accordance with the item data to retrieve the second information and determines whether or not the input product data includes the retrieved second information (see column 25, lines 42-49).

As per claim 9, Kaish discloses:

- transmitting means for transmitting a determination result to a predetermined terminal when the third determining means determines that the product is a counterfeit product (column 25, lines 42-49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaish, in view of Official Notice.

As per claim 6, Kaish discloses:

- the image comprises a micro-character (see Figure 1, reference numbers 8, 10.

Kaish does not explicitly disclose using a micro-character to further the security of the system. The Examiner takes Official Notice that using micro-characters for providing a higher lever of visual security was well known to those skilled in the art at the time of the invention. These characters were well known to those skilled in the art at the time of the invention to provide an easily-authenticated system of physical objects. Due to the desire to easily authenticate items using micro-characters being well known to those skilled in the art at the time of the invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use micro-characters in conjunction with the system in Kaish, to give a higher degree of security).

Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaish, in view of Official Notice.

As per claim 10, Kaish discloses:

- the inputting means inputs user information, a determination request, and the product data from a user terminal (see column 26, lines 28-47);
- and the information processing apparatus further comprises transmitting means for transmitting a determination result obtained by the third determining means and the user information to a predetermined terminal (see column 25, lines 42-49. Kaish does not explicitly disclose that the user information is transmitted to the remote site. There is a desire in the system in Kaish to provide a secure method of authenticating products – evidence exists in column 26, lines 33 – 36. Clearly there is a desire for security, and sending along the authenticated user information would allow for a higher degree of security in the system. Additionally, it was obvious to one skilled in the art at the time of the invention to send usernames with secure communication, in order to authenticate transactions. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the user information to the remote site, in order to provide a higher level of security).

Conclusion

The Examiner would greatly appreciate a translation of the Chinese Office Action, as mentioned by applicant's representative in the Information Disclosure Statement of 14 November 2005, as it would aid the Office in examination.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. A website posting entitled "Micro Characters on New 500-Yen Coin Found !!" concerns the usage of micro-characters for visual verification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is 571-270-3462. The examiner can normally be reached on Monday-Thursday, 7:30-5, Alternate Fridays, 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Johns/
Examiner, Art Unit 4172

Christopher Johns
Examiner
Art Unit 4172

/Naeem Haq/
Primary Examiner, Art Unit 4172

Jan 08